

### REMARKS

Claims 1-2, 4-5, 7-8, 10-11, 13-17 and 20-30 are pending in the present application. By this Amendment, the specification has been amended; previously presented claims 1, 10, 13, 16 and 20-21 have been amended; previously presented claims 3, 6, 9, 12 and 18-19 have been canceled; and new claims 25-30 have been added. Applicants respectfully request reconsideration of the present claims in view of the foregoing amendment and the following remarks.

#### I. Formal Matters:

##### Allowable Subject Matter

Applicants note that previously presented claim 16 has not been rejected over the art of record. Applicants respectfully submit that presently presented claim 16, as well as presently presented claims 1-2, 4-5, 7-8, 10-11, 13-15, 17 and 20-30, are allowable over the art of record for at least the reasons provided below.

##### Claim Rejections Under 35 U.S.C. § 112, First Paragraph

Previously presented claim 23 was rejected under 35 U.S.C. §112, first paragraph, as allegedly failing to meet the written description requirement of 35 U.S.C. §112, first paragraph. This rejection is respectfully traversed.

Beginning on page 3, line 16 of the July 11, 2006 Office Action, Examiner Oh states:

Claim 23 is rejected under 35 U.S.C. §112, first paragraph, because the specification, while being enabled for an acid catalyst, such as, sulfuric acid, nitric acid, hydrochloric acid, hydrobromic acid, hydriodic acid, trifluoroacetic acid, does not reasonably provide enablement for all catalysts known in the field of chemistry. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to include all the catalysts unrelated to the invention commensurate in scope with these claims.

Applicants note that claim 23 is directed to the process of claim 1 wherein the diol and the carboxylic acid are reacted in the presence of an acid catalyst, not any known catalyst in

the field of chemistry. Examiner Oh has stated above that the specification is enabling for acid catalysts. Consequently, Applicants do not understand why claim 23 is being rejected under 35 U.S.C. §112, first paragraph.

For at least the reasons given above, Applicants respectfully submit that claim 23 meets the written description requirement of 35 U.S.C. §112, first paragraph. Accordingly, withdrawal of this rejection is respectfully requested.

Claim Rejections Under 35 U.S.C. § 112, Second Paragraph

Previously presented claims 1-24 were rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. This rejection is respectfully traversed.

Although Applicants do not agree that the terms “sufficiently”, “substantially” and “about” as used in the previously presented claims render the claims indefinite, in order to expedite prosecution of the present application, Applicants have amended the claims as shown above to remove terms objected to by Examiner Oh, including the terms “sufficiently”, “substantially” and “about” in various locations within previously presented claims 1-24.

For at least the reasons given above, Applicants respectfully submit that presently presented claims meet the definiteness requirement of 35 U.S.C. §112, second paragraph. Accordingly, withdrawal of this rejection is respectfully requested.

II. Prior Art Rejections:

Rejection of Previously Presented Claims 1-15 and 17-24 Under 35 U.S.C. §103(a) In View Of Babler

Previously presented claims 1-15 and 17-24 were rejected under 35 U.S.C. §103(a) as being unpatentable over Babler et al., “A Facile Method For Monoacetylation of Symmetrical Diols: Application to the Total Synthesis of Z-8-Dodecenyl Acetate, The Sex Attractant of the Oriental Fruit Moth”, Tetrahedron Letters No. 22, pages 1971-1974 (1979) (hereinafter, “Babler”). This rejection is respectfully traversed.

Applicants' claimed process recited in independent claim 1 comprises, *inter alia*, the step of reacting at least one diol with at least one carboxylic acid in a biphasic solvent system comprising water and at least one aprotic solvent, wherein the carboxylic acid has a water solubility that allows esterification to occur so as to form a resulting monoester having a greater solubility in the at least one aprotic solvent than in water, wherein the process is conducted without a continuous extraction step. As disclosed throughout Applicants' original specification, the process of the present invention does not require specialized equipment, such as a continuous extraction apparatus, or expensive reagents in order to produce monoesters. See, for example, page 2, lines 21-33, page 3, lines 19-24, and the Examples of Applicants' original specification.

The teaching of Babler is directed to a method of making monoacetates using a continuous extraction process.

The teaching of Babler fails to disclose, teach or suggest a process for preparing a monoester as recited in independent claim 1. In particular, the teaching of Babler fails to disclose, teach or suggest the use of a biphasic solvent system comprising water and at least one aprotic solvent as a reaction mixture for carrying out the reaction of a diol with a carboxylic acid. Further, as noted above, the teaching of Babler fails to disclose, teach or suggest a process for preparing a monoester without a continuous extraction step.

For at least the reasons given above, Applicants respectfully submit that the teaching of Babler fails to make obvious Applicants' claimed invention as recited in independent claim 1. Since claims 2, 4-5, 7-8, 10-11, 13-15, 17 and 20-24 depend from independent claim 1 and recite additional claim features (previously presented claims 3, 6, 9, 12 and 18-19 have been canceled), the teaching of Babler also fails to make obvious Applicants' claimed invention as recited in dependent claims 2, 4-5, 7-8, 10-11, 13-15, 17 and 20-24. Accordingly, withdrawal of this rejection is respectfully requested.

### III. New Claims 25-30:

New claims 25-30 are directed to various embodiments of Applicants' invention. Support for new claims 25-30 may be found in at least the following locations of Applicants' original specification: the Table on page 21 (claim 25); page 13, lines 15-18 (claim 26); page 2,

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lines 22-25, page 3, lines 22-24, and page 7, line 22 to page 9, line 13 (claims 27 and 30); page 4, lines 22-33, and page 7, lines 16-19 (claim 28); and page 8, lines 24-27 (claim 29).

Applicants respectfully submit that new claims 25-30 are patentable over the art of record for at least the reasons given above.

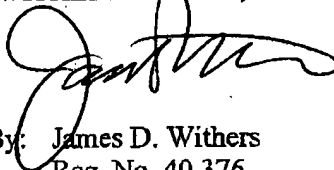
IV. Conclusion:

Applicants respectfully submit that claims 1-2, 4-5, 7-8, 10-11, 13-17 and 20-30 define patentable subject matter. Accordingly, Applicants respectfully request allowance of these claims.

No additional fees are believed due; however, the Commissioner is hereby authorized to charge any deficiency, or credit any overpayment, to Deposit Account No. 503025.

Should Examiner Oh believe that anything further is necessary to place the application in better condition for allowance, Examiner Oh is respectfully requested to contact Applicants' representative at the telephone number listed below.

Respectfully submitted,  
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